

REMARKS

Claims 1-18 and 23-26 are pending in the present application.

Applicants wish to thank Examiner Berman for indicating that the rejections over Ohmae et al (US 5,208,016), EP 0 862 858, and Ottersbach et al (US 5,967,714) have been withdrawn (October 22, 2003 Office Action, page 2, lines 1-4). Reconsideration of the remaining grounds of rejection is requested.

The only remaining rejections in the present application are an obviousness double patenting rejection over US 5,967,714 and the provisional obviousness double patenting rejections over US application 09/926,470, US application 09/926,507, US application 09/926,510, US application 10/070,813, and US application 10/070,817.

Regarding the obviousness double patenting rejection of Claims 10-18 and 23-26 over US 5,967,714, Applicants note that in order to be a proper obviousness double patenting rejection, the *claims* of US 5,967,714 must render the Claims 10-18 and 23-26 obvious. Applicants submit that this condition is not satisfied in the present application.

First, the claims of US 5,967,714 differ from the rejected claims in that the claims of US 5,967,714 require the presence of a polymer-containing surface of an apparatus or article. The presently claims has no such requirement and/or limitation.

Second, the antimicrobial polymer in the claims of US 5,967,714 is formed "by graft copolymerizing tertbutylaminoethyl methacrylate with at least one other aliphatically unsaturated monomer." Although tertbutylaminoethyl methacrylate may qualify as component II, US 5,967,714 does not disclose or suggest an aliphatically unsaturated monomer functionalized by an ester group *and* a tertiary amino group (component I).

Third, the Examiner has already conceded novelty of the present invention over the disclosure of US 5,967,714 stating: "Neither Ohmae et al nor Ottersbach et al disclose or suggest copolymerizing the disclosed amino unsaturated monomers with an aliphatically unsaturated monomer functionalized by means of an ester group and at least singly functionalized by means of a tertiary amino group." (October 22, 2003 Office Action, page 2, lines 6-10) Therefore, if the disclosure of US 5,967,714 fails to render the presently claimed invention obvious, then certainly the claims must also fail.

In view of the foregoing, Applicants traverse the obviousness double patenting rejection over US 5,967,714 and request withdrawal of the same.

Finally, with respect to the provisional obviousness double patenting rejections over US application 09/926,470, US application 09/926,507, US application 09/926,510, US application 10/070,813, and US application 10/070,817, Applicants remind the Examiner that the MPEP §804 states: "If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent..." In view of the comments above regarding the obviousness double patenting rejection over US 5,967,714, Applicant request withdrawal of the provisional obviousness double patenting rejections.

If, for any reason, the Examiner maintains the obviousness double patenting rejection over US 5,967,714, Applicants request that the provisional obviousness double patenting rejections be held in abeyance until such a time that they are the only remaining rejections. At that time, these provisional rejections should be withdrawn

Applicants note that all of the presently pending claims have been fully searched on the merits and no amendments have been made in response to the outstanding Office Action.

Therefore, any new ground of rejection cannot be reasonably considered to have been necessitated by Applicants' amendment. Accordingly, it is expected that any new ground of rejection would be in a new non-final Office Action.

Applicants submit that the present application is now in condition for allowance.
Early notification of such action is earnestly solicited.

Respectfully submitted,

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